

TO: <b>Mail Stop 8</b> <b>Director of the U.S. Patent and Trademark Office</b> <b>P.O. Box 1450</b> <b>Alexandria, VA 22313-1450</b>	<b>REPORT ON THE</b> <b>FILING OR DETERMINATION OF AN</b> <b>ACTION REGARDING A PATENT OR TRADEMARK</b>
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court San Diego on the following Patents or Trademarks:

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
09-CV-0808-WQH (NLS)	04/17/2009	Southern District of California
PLAINTIFF	DEFENDANT	
Oakley, Inc.	Bushnell, Inc.	
PATENT OR TRADEMARK NO.	PATENT OR TRADEMARK NO.	PATENT OR TRADEMARK NO.
1 See Complaint 5,387,949	6	11
2 5,208,614 5,137,342	7	12
3 5,054,903 5,354,968	8	13
4	9	14
5	10	15

In the above-entitled case, the following patent(s)/trademark(s) have been included:

DATE INCLUDED	INCLUDED BY		
	<input type="checkbox"/> Amendment	<input type="checkbox"/> Answer	<input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading
PATENT OR TRADEMARK NO.	PATENT OR TRADEMARK NO.	PATENT OR TRADEMARK NO.	
1	6	11	
2	7	12	
3	8	13	
4	9	14	
5	10	15	

In the above-entitled case, the following decision has been rendered or judgment issued:

DECISION/JUDGMENT		
<i>Attached</i>		
CLERK	(BY) DEPUTY CLERK	DATE
W. Samuel Hamrick, Jr.	<i>8/10/09</i>	<i>8/10/09</i>

**FIFTH CLAIM FOR RELIEF**

**Patent Infringement (U.S. Patent No. D354,968)**

49. The allegations of paragraphs 1 through 18 are replied and realleged as though fully set forth herein.

50. This is a claim for patent infringement, and arises under 35 U.S.C. §§ 271 and 281 against Defendant.

51. Jurisdiction is founded upon 28 U.S.C. §§ 1331 and 1338.

52. Oakley is the owner of U.S. Patent No. D354,968, which protects the design and ornamentation of an eyeglass lens embodied and marketed by Oakley as part of the name "M Frame". A true and correct copy of U.S. Patent No. D354,968 is attached hereto as Exhibit 5. By statute, the patent is presumed to be valid and enforceable under 35 U.S.C. § 282.

53. Defendant, through its respective agents, employees and servants, manufactured, imported, used, offered for sale, and/or sold, without any rights or license, eyeglasses that fall within the scope and claim contained in U.S. Patent No. D354,968.

54. Oakley is informed and believes and thereupon alleges that Defendant has willfully infringed upon Oakley's exclusive rights under the '968 patent, with full notice and knowledge thereof. Defendant sold and is selling such infringing sunglasses, and will continue to do so unless restrained therefrom by this court, all to the great loss and injury of Oakley.

55. Oakley is informed and believes and thereupon alleges that Defendant has derived, received, and will continue to derive and receive from its acts of infringement, gains, profits and advantages in an amount not presently known to Oakley. By reason of these acts of infringement, Oakley has been, and will continue to be, greatly damaged.

56. Defendant will continue to infringe U.S. Patent No. D354,968 to the great and irreparable injury of Oakley, for which Oakley has no adequate remedy

1 at law unless said Defendant is enjoined by this court.

2 WHEREFORE, Plaintiff Oakley, Inc. prays as follows:

3 1. That Defendant be adjudicated to have infringed Oakley's U.S. Patent  
4 Nos. 5,387,949, 5,208,614, 5,137,342, 5,054,903, D354,968, and that the patents  
5 are valid, enforceable, and owned by Oakley;

6 2. That Defendant, its agents, servants, employees, and attorneys and all  
7 persons in active concert and participation with them, be forthwith preliminarily  
8 and thereafter permanently enjoined from making, using or selling any eyewear  
9 which infringe United States Patent Nos. 5,387,949, 5,208,614, D354,968;

10 3. For an assessment and award of damages against Defendant Bolle in  
11 an amount no less than lost profits, reasonable royalty, or Defendant's profits  
12 derived from its infringement of Plaintiff's patent rights, pursuant to 35 U.S.C. §§  
13 284 and 289;

14 4. For an order requiring Defendant to deliver up and destroy all  
15 infringing eyewear;


16 5. That an award of reasonable costs, expenses, and attorney's fees be  
17 awarded against Defendant pursuant to 35 U.S.C. § 285;

18 6. That Defendant be directed to file with this court and serve upon  
19 Oakley within 30 days after the service of the injunction, a report in writing under  
20 oath, setting forth in detail the manner and form in which Defendant has complied  
21 with the injunction; and

22 7. For such other relief as the Court may deem appropriate.

23  
24 DATED: 4/16/09

WEEKS, KAUFMAN, NELSON & JOHNSON

25  
26   
27 GREGORY K. NELSON  
28 Attorney for Plaintiff, Oakley, Inc.

1  
2 JURY DEMAND

3 Plaintiff Oakley, Inc. hereby requests a trial by jury in this matter.

4 DATED:

5 4/16/09

6 WEEKS, KAUFMAN, NELSON & JOHNSON

7 

8 GREGORY K. NELSON

9 Attorney for Plaintiff, Oakley, Inc.  
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9 Attorneys for Plaintiff

10 UNITED STATES DISTRICT COURT  
11 SOUTHERN DISTRICT OF CALIFORNIA

12 OAKLEY, INC., a Washington  
13 corporation,

14 Plaintiff,

15 vs.

16 BUSHNELL, INC., a Delaware  
17 corporation,

18 Defendant.

Case No.: 09 CV 0808 WQH (NLS)

NOTICE OF VOLUNTARY  
DISMISSAL WITH PREJUDICE

19 NOTICE IS HEREBY GIVEN THAT pursuant to Federal Rule of Civil  
20 Procedure, Rule 41(a), Plaintiff hereby voluntarily dismisses Defendant Bushnell,  
21 Inc. in the above captioned action with prejudice.

22 DATED: July 20, 2009

WEEKS, KAUFMAN, NELSON & JOHNSON

23 /s/ Gregory K. Nelson

24 GREGORY K. NELSON

25 Attorney for Plaintiff, Oakley, Inc.  
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FILED

2009 APR 17 PM 2:59

CLERK US DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

BY                      DEPUTY

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Attorneys for Plaintiff

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

OAKLEY, INC., a Washington  
corporation,

Plaintiff,

vs.

BUSHNELL, INC., a Delaware  
corporation

Defendant.

Case No. 09CV0808WQH NLS

COMPLAINT FOR PATENT  
INFRINGEMENT

JURY TRIAL

Plaintiff OAKLEY, INC. (hereinafter referred to as "Oakley") hereby complains of Defendants BUSHNELL, INC. (hereinafter referred to as "Bolle") and alleges as follows:

**JURISDICTION AND VENUE**

1. Jurisdiction over this action is founded upon 15 U.S.C. § 1121, and 28 U.S.C. §§ 1331 and 1338.

2. Venue is proper under 28 U.S.C. §§ 1391(b) and (c) and 28 U.S.C. § 1400(b). The Defendant sold infringing products in this district and has directed sales and marketing efforts toward this district.

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**THE PARTIES**

3. Plaintiff Oakley is a corporation organized and existing under the laws of the State of Washington, having its principal place of business at One Icon, Foothill Ranch, California, 92610 and doing business within this judicial district.

4. Oakley is informed and believes, and thereupon alleges that Defendant Bushnell, Inc. is a Delaware corporation doing business at 9200 Cody, Overland Park, Kansas, 66214, and doing business under the brand name Bolle.

**FACTUAL BACKGROUND**

5. As early as 1985, Oakley has been and continues to be actively engaged in the manufacture and sale of high quality sport sunglasses under various product lines. Oakley is the manufacturer and retailer of several lines of sunglasses, including its "M Frame®", "Half Jacket®", and "Flak Jacket®" sunglass lines.

6. Oakley is the owner by assignment of U.S. Patent No. 5,387,949, duly and lawfully issued on February 7, 1995, describing and claiming the invention entitled "Eyeglass Connection Device", which protects the described and claimed technology, that is embodied by Oakley's "Zero", "Half Jacket" and "Flak Jacket" lines of eyeglasses. A correct copy of U.S. Patent No. 5,387,949 is attached hereto as Exhibit 1.

7. Oakley is informed and believes, and thereupon alleges that Defendant Bolle, is selling sunglasses that copy the claimed technology of Oakley's U.S. Patent No. 5,387,949. In particular, Oakley alleges that Bolle's "Warrant" and "Shift" eyewear models embody the subject matter claimed in Oakley's patent referred to above without any license thereunder and thereby infringes this patent. Oakley is informed and believes, and based thereon, alleges that Defendant, Bolle sold infringing sunglasses to various distributors, retailers, and retail customers, including within this judicial district.

1           8. Oakley is the owner by assignment of U.S. Patent No. 5,208,614 duly  
2 and lawfully issued on September 30, 1997, describing and claiming the invention  
3 entitled "Concavely Indented Lenses For Eyewear" protecting the technology for  
4 an improved eyeglass lens for sunglasses. A true copy of U.S. Patent No.  
5 5,208,614 is attached hereto as Exhibit 2.

6           9. Oakley is informed and believes, and thereupon alleges that the  
7 Defendant is selling eyewear that infringes U.S. Patent No. 5,208,614 of Oakley.  
8 Oakley alleges that Bolle's "Microedge", "Edge", and "Marksman" eyewear  
9 models embody the subject matter claimed in Oakley's U.S. Patent No. 5,208,614,  
10 without any license thereunder and is thereby infringing the patent. Oakley is  
11 informed and believes and based thereon alleges that Bolle sold infringing  
12 sunglasses to various distributors, retailers, and retail customers, including within  
13 this judicial district.

14           10. Oakley is the owner by assignment of U.S. Patent No. 5,137,342 duly  
15 and lawfully issued on August 11, 1992, describing and claiming the invention  
16 entitled "Eyewear Traction Device" protecting the technology for an improved  
17 earstem and traction device for sunglasses. A true copy of U.S. Patent No.  
18 5,137,342 is attached hereto as Exhibit 3.

19           11. Oakley is the owner by assignment of U.S. Patent No. 5,054,903 duly  
20 and lawfully issued on October 8, 1991, describing and claiming the invention  
21 entitled "Eyewear Traction Device" protecting the technology for an improved  
22 earstem and traction device for sunglasses. A true copy of U.S. Patent No.  
23 5,054,903 is attached hereto as Exhibit 4.

24           12. Oakley is informed and believes, and thereupon alleges that Bolle sold  
25 eyeglasses that infringe U.S. Patent Nos. 5,137,342 and 5,054,903 of Oakley.  
26 Oakley alleges that Bolle's "Clutch", "Microedge", "Score", "Edge", and  
27 "Marksman" eyewear models embody the subject matter claimed in Oakley's U.S.  
28 Patent Nos. 5,137,342 and 5,054,903 without any license thereunder and is thereby



1 infringed these patent. Oakley is informed and believes and based thereon alleges  
2 that Defendant, Bolle sold infringing sunglasses to various distributors, retailers,  
3 and retail customers.

4 13. Oakley's U.S. Patent Nos. 5,137,342 and 5,054,903 expired October 8,  
5 2008. Nonetheless, Oakley is informed and believes, and thereupon alleges, that  
6 Bolle made, used, imported, offered for sale and/or sold the "Clutch",  
7 "Microedge", "Score", "Edge", and "Marksman" eyewear models prior to the  
8 expiration of these patents, without license from Oakley.

9 14. Oakley is the owner by assignment of U.S. Design Patent No.  
10 D354,968, duly and lawfully issued on January 31, 1995, describing and claiming  
11 the invention entitled "Eyeglass Lens," which is embodied by the *M-Frame*  
12 eyeglass, made and sold by Oakley. A correct copy of U.S. Design Patent No.  
13 D354,968 is attached hereto as Exhibit 5.

14 15. Oakley is informed and believes, and thereupon alleges that Bolle is  
15 selling eyewear that copies the design of the D354,968 patent of Oakley.  
16 Specifically, Oakley alleges that Bolle's "Score" eyewear model, sold by  
17 Defendant, embodies the subject matter claimed in Oakley's design patent referred  
18 to above without any license thereunder and is thereby infringing said patent.  
19 Oakley is informed and believes and based thereon alleges that Defendant, Bolle  
20 sold infringing sunglasses to various distributors, retailers, and retail customers.

21 16. Defendant has received written notice of Oakley's proprietary rights in  
22 its patents by way of this lawsuit. Further, Defendant has received constructive  
23 notice of Oakley's patents as Oakley caused its patents to be placed plainly on the  
24 product and/or packaging. Despite actual and constructive knowledge, Defendant  
25 continues to infringe Oakley's patent rights. On information and belief, such  
26 infringement by Defendant must have been willful and wanton.

27 17. Oakley is informed and believes and thereupon alleges that the sale of  
28 the unauthorized, infringing eyewear has resulted in lost sales, has reduced the

1 business and profit of Oakley, and has greatly injured the general reputation of  
2 Oakley due to the inferior quality of the copies, all to Oakley's damage in an  
3 amount not yet fully determined.

4 18. The exact amount of profits realized by Defendant as a result of its  
5 infringing activities, are presently unknown to Oakley, as are the exact amount of  
6 damages suffered by Oakley as a result of said activities. These profits and  
7 damages cannot be accurately ascertained without an accounting.

#### 8 **FIRST CLAIM FOR RELIEF**

##### 9 **Patent Infringement (U.S. Patent No. 5,387,949)**

10 19. The allegations of paragraphs 1 through 18 are replied and realleged as  
11 though fully set forth herein.

12 20. This is a claim for patent infringement, and arises under 35 U.S.C. §§  
13 271 and 281.

14 21. Jurisdiction is founded upon 28 U.S.C. §§ 1331 and 1338.

15 22. Oakley is the owner of U.S. Patent No. 5,387,949, which protects  
16 technology for an eyeglass connection embodied by Oakley's "Half Jacket" and  
17 "Flak Jacket" products, among others. A true and correct copy of U.S. Patent No.  
18 5,387,949 is attached hereto as Exhibit 1. By statute, the patent is presumed to be  
19 valid and enforceable under 35 U.S.C. § 282.

20 23. Defendant, through its agents, employees and servants, manufactured,  
21 imported, offered to sell, and sold, without any rights or license, eyewear that falls  
22 within the scope and claim contained in U.S. Patent No. 5,387,949, including but  
23 not limited to those set out above.

24 24. Oakley is informed and believes and thereupon alleges that Defendant  
25 has willfully infringed upon Oakley's exclusive rights under the '949 patent, with  
26 full notice and knowledge thereof. Defendant sold or is selling such infringing  
27 sunglasses, has refused to cease the sale thereof, and will continue to do so unless  
28 restrained therefrom by this court, all to the great loss and injury of Oakley.

1           25. Oakley is informed and believes and thereupon alleges that Defendant  
2 has derived, received, and will continue to derive and receive from its acts of  
3 infringement, gains, profits and advantages in an amount not presently known to  
4 Oakley. By reason of these acts of infringement, Oakley has been, and will  
5 continue to be, greatly damaged.

6           26. Defendant will continue to infringe U.S. Patent No. 5,387,949 to the  
7 great and irreparable injury of Oakley, for which Oakley has no adequate remedy  
8 at law unless the Defendant is enjoined by this court.

9                           **SECOND CLAIM FOR RELIEF**

10                   **Patent Infringement (U.S. Patent No. 5,208,614)**

11           27. The allegations of paragraphs 1 through 18 are replied and realleged as  
12 though fully set forth herein.

13           28. This is a claim for patent infringement, and arises under 35 U.S.C. §§  
14 271 and 281 against Defendant.

15           29. Jurisdiction is founded upon 28 U.S.C. §§ 1331 and 1338.

16           30. Oakley is the owner of U.S. Patent No. 5,208,614 claiming an  
17 concavely indented lens for eyewear. A true and correct copy of U.S. Patent No.  
18 5,208,614 is attached hereto as Exhibit 2. By statute, the patent is presumed to be  
19 valid and enforceable under 35 U.S.C. § 282.

20           31. Defendant, through its respective agents, employees and servants,  
21 manufactured, imported, used, offered for sale, and/or sold, without any rights or  
22 license, eyeglasses that fall within the scope and claim contained in U.S. Patent  
23 No. 5,208,614.

24           32. Oakley is informed and believes and thereupon alleges that Defendant  
25 has willfully infringed upon Oakley's exclusive rights under said patent, with full  
26 notice and knowledge thereof. Defendant sold or is selling such infringing  
27 sunglasses, has refused to cease the sale thereof, and will continue to do so unless  
28 restrained therefrom by this court, all to the great loss and injury of Oakley.

1           33. Oakley is informed and believes and thereupon alleges that Defendant  
2 has derived, received and will continue to derive and receive from its acts of  
3 infringement, gains, profits and advantages in an amount not presently known to  
4 Oakley. By reason of these acts of infringement, Oakley has been, and will  
5 continue to be, greatly damaged.

6           34. Defendant will continue to infringe U.S. Patent No. 5,208,614 to the  
7 great and irreparable injury of Oakley, for which Oakley has no adequate remedy  
8 at law unless the Defendant is enjoined by this court.

9                           **THIRD CLAIM FOR RELIEF**

10                          **Patent Infringement (U.S. Patent No. 5,137,342)**

11           35. The allegations of paragraphs 1 through 18 are rep'd and realleged as  
12 though fully set forth herein.

13           36. This is a claim for patent infringement, and arises under 35 U.S.C. §§  
14 271 and 281 against Defendant Bolle.

15           37. Jurisdiction is founded upon 28 U.S.C. §§ 1331 and 1338.

16           38. Oakley is the owner of U.S. Patent No. 5,137,342 claiming an  
17 improved earstem and traction device for sunglasses, which is now expired. A true  
18 and correct copy of U.S. Patent No. 5,137,342 is attached hereto as Exhibit 3. By  
19 statute, the patent is presumed to be valid and enforceable under 35 U.S.C. § 282.

20           39. Defendant, through its respective agents, employees and servants,  
21 manufactured, imported, used, offered for sale and/or sold, without any rights or  
22 license, eyeglasses that fall within the scope and claim contained in U.S. Patent  
23 No. 5,137,342 during the life of the patent.

24           40. Oakley is informed and believes, and thereupon alleges, that  
25 Defendant has willfully infringed upon Oakley's exclusive rights under the '342  
26 patent, with full notice and knowledge thereof. Defendant sold such infringing  
27 sunglasses, to the great loss and injury of Oakley.

28           41. Oakley is informed and believes, and thereupon alleges, that

1 Defendant, has derived and received from its acts of infringement, gains, profits  
2 and advantages in an amount not presently known to Oakley. By reason of these  
3 acts of infringement, Oakley has been greatly damaged.

#### 4 **FOURTH CLAIM FOR RELIEF**

##### 5 **Patent Infringement (U.S. Patent No. 5,054,903)**

6 42. The allegations of paragraphs 1 through 18 are replied and realleged as  
7 though fully set forth herein.

8 43. This is a claim for patent infringement, and arises under 35 U.S.C. §§  
9 271 and 281 against Defendant.

10 44. Jurisdiction is founded upon 28 U.S.C. §§ 1331 and 1338.

11 45. Oakley is the owner of U.S. Patent No. 5,054,903 claiming an  
12 improved earstem and traction device for sunglasses, which is now expired. A true  
13 and correct copy of U.S. Patent No. 5,054,903 is attached hereto as Exhibit 4. By  
14 statute, the patent is presumed to be valid and enforceable under 35 U.S.C. § 282.

15 46. Defendant, through its respective agents, employees and servants,  
16 manufactured, imported, used, offered for sale, and/or sold, without any rights or  
17 license, sunglasses which fall within the scope and claim contained in U.S. Patent  
18 No. 5,054,903.

19 47. Oakley is informed and believes, and thereupon alleges, that  
20 Defendant has willfully infringed upon Oakley's exclusive rights under said patent,  
21 with full notice and knowledge thereof. Defendant sold such infringing sunglasses,  
22 to the great loss and injury of Oakley.

23 48. Oakley is informed and believes, and thereupon alleges, that  
24 Defendant, has derived and received from its acts of infringement, gains, profits  
25 and advantages in an amount not presently known to Oakley. By reason of these  
26 acts of infringement, Oakley has been greatly damaged.

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